

Appl. No. 10/817,093

After Final Amendment dated February 10, 2006

Amendments to the Drawings:

None.

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REMARKS/ARGUMENTS

The applicant and applicant's representative wish to thank the examiner for the courtesy of an interview on February 10, 2006. Revisions to independent claim 1 and to dependent claim 17, which was indicated to contain allowable subject matter, were discussed as was cited U.S. Patent No. 5,613,612. No agreement was reached during that interview.

Cancellation of claims 10 through 15 is requested without acquiescence to their rejections and without prejudice to their being presented in a subsequent application.

Claims 17 and 18 were objected to for being dependent from a rejected base claim. Claim 17 depended from independent claim 16 and claim 18 depended from claim 17. Both claims were indicated to be allowable if rewritten in independent form to include all limitations of the claims from which they depended. To address those objections, amendment of claim 17 is requested to place it in independent form including all limitations of claim 16.

In addition to amendment to independent form, amendment of claim 17 is requested to correct an inadvertent error in that claim that introduced inconsistent requirements. One step of claim 17 required "causing the band . . . to extend around the package to secure the pop-up display package decoration to the package", while another step required "extending the band *at least partially around* the package to secure the pop-up display package decoration to the package." Emphasis added. Amendment of claim 17 is requested to cancel the first requirement so that the complete requirement concerning the relationship of the band to the package is the second and remaining requirement that the band extend at least partially around the package to secure the pop-up display package decoration to the package. Amendment of claim 17 is also requested, consistent with the requirement that the band be extended at least partially around the package, to require that the band that is provided be sized to extend at least partially around the package. The applicant submits that these amendments do not affect the allowability of claim 17. The applicant requests entry of these amendments and that the allowability of claim 17 as so amended be sustained.

Claim 1 was rejected by the Final Action as unpatentable under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,613,612 (Davault '612) and claim 16 was rejected under 35

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U.S.C. § 103(a) as an obvious method of decorating the package of Davault '612.

Davault '612 is directed to the combination of a pop-up display and CD holder. The pop-up display of Davault '612 is contained within the CD holder (Figs. 1 – 3, col. 3 lines 48 – 50). The Davault '612 pop-up display has a foldable panel having two sections, 22 and 30. Those sections do not overlie an outwardly facing side of the CD holder, and do not even overlie a single side. Rather, those two sections of the foldable panel attach to two different parts of the CD holder that are hinged to each other, to the tray 24 and to the cover 16. Figs. 1 and 2, col. 4 lines 7 – 20. Further, in the open position of the display 10 of the Davault '612, the foldable panels are approximately perpendicular to each other. Fig. 1, col. 3 lines 52 – 58. The display 10 disclosed by Davault '612 appears to be unusable when the sections 22 and 30 overlie the same side of a package.

The requested amendments to claim 1 make clear that the claimed pop-up display is positioned on a single outwardly facing side of a package, and more specifically that both the first and second sections of the foldable panel overlie that outwardly facing side of the package. As so amended, claim 1 distinguishes over Davault '612 for requiring a foldable panel that overlies an outwardly facing side, rather than inner surfaces, of a package, and for requiring that both sections of the foldable panel overlie the same package side. Amendment of claim 16 is requested to similarly distinguish that claim from Davault '612. Davault '612 does not anticipate claim 1 as amended, and does not render obvious the method of claim 16 as amended.

CONCLUSION

The newly cited Davault '612 reference is directed to the combination of a pop-up display and CD holder. That combination is distinct from applicant's package decoration invention. The applicant requests entry of the submitted amendments to claims 1 and 16 to clearly distinguish the scope of those claims from Davault '612. Applicant submits that these amendments do not raise additional issues, but clarify the scope of applicant's invention as distinct from this newly cited reference. Applicant submits that these claims, as amended, continue to distinguish over the other art of record, and that none of the art of record anticipates or renders obvious these

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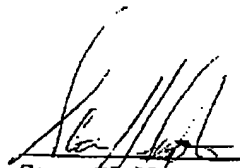
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claims. Applicant submits that claims 1 through 9 and 16, 19 and 20 are allowable for at least the reasons that claims 1 and 16 are allowable. Applicant submits that claims 17 and 18 are now allowable as indicated by the Final Action. The Applicant requests that all pending claims be allowed.

If the Examiner believes that a discussion of these claims would be useful, the Applicants request that the Examiner contact Applicants' undersigned attorney at (312) 775-8114. Please charge any additional fees or credit overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: February 10, 2006



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